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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,849	02/09/2004	David L. Spivey	3132R	9514

7590 11/15/2007
THE LUBRIZOL CORPORATION
Patent Dept. - Patent Administrator-022B
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/774,849	Applicant(s) SPIVEY ET AL.	
	Examiner Cephia D. Toomer	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed August 30, 2007.

The rejection of the claims under 35 U.S.C. 112 is withdrawn in view of the amendment to the claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2002102942.

WO teaches a fuel additive detergent composition comprising a succinic acylating agent/amine reaction product (see abstract). The fuel has a sulfur content of 0.002 % by wt or less and the additive may include a solvent such as aliphatic hydrocarbons (see page 10, lines 7-9 and claims 12-13). The reactants in the reaction product are PIB-substituted succinic acids and polyamines wherein the PIB has a molecular weight from 400-2500 (see claims 1, 5 and 6). WO teaches the limitations of the claims other than the differences that are discussed below.

WO fails to teach the sulfur content of the solvent. However, no unobviousness is seen in this difference because WO teaches that the fuel composition is a low-sulfur

fuel composition and the skilled artisan would desire to use a solvent that is substantially free or free of sulfur.

With respect to the flash point of the solvent, it would have been obvious to one of ordinary skill in the art to select solvents possessing the claimed flash points because the skilled artisan would recognize the need to select a solvent that would have a high flash point in order to not increase the volatility of the fuel composition.

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2002102942 in view of Cunningham (US 5,679,116).

WO has been discussed above and is herein incorporated by reference.

WO fails to teach the detergent/dispersant of the claim. However, Cunningham teaches that the detergent/dispersant taught by WO is an art recognized equivalent of hydrocarblyl-substituted amines and Mannich reaction products (see abstract).

It would have been obvious to one of ordinary skill in the art to replace the detergent of WO with one of those of Cunningham given that Cunningham teaches that the compounds are art recognize equivalents. The skilled artisan would have the reasonable expectation that the amines and Mannich reaction products would perform their attendant functions.

4. Applicant argues that WO does not exemplify solvents that are within the scope of the claimed solvent. Applicant argues that the declaration of Dr. Pudelski show unexpected results with the use of the claimed solvent.

It is well settled that a reference is relied upon for all that it teaches and not for the examples contained therein. WO clearly teaches that aliphatic solvents are within

the scope of his invention. It is the examiner's position is that the skilled artisan would desire a high flashpoint solvent that also contains low levels of sulfur. It is well known that because of environmental concerns that fuels are produced containing low levels of sulfur. The skilled artisan would also desire a high flashpoint, low sulfur solvent for the same reason.

Applicant's declaration and data have been considered but are not deemed to constitute unexpected results. The showings are not commensurate in scope with the claims. Claim 1 is generic in all respects. Applicant uses a specific detergent and solvent in the example. While claim 20 recites broad classes of detergent/dispersants, it too is far broader than the example. The examiner cannot ascertain if the thousands of possible compounds/solvent combinations would produce the same results as those set forth in the example.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

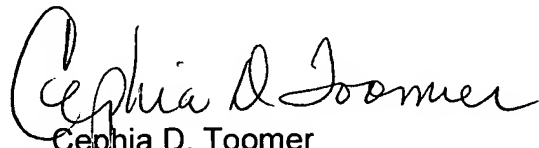
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cephia D. Toomer
Primary Examiner
Art Unit 1797